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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,266	03/28/2001	Agamemnon Antoniou Epenetos	JG-EPC-4955P/500563.20004	4300

26418 7590 08/27/2002

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

DAVIS, MINH TAM B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/27/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,266

Applicant(s)

EPENETOS, AGAMEMNON
ANTONIOU

Examiner

MINH-TAM DAVIS

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

After review and reconsideration, the restriction of paper No:12 on 05/07/2002 is vacated. A new restriction is required.

Election/Restrictions

It is noted that the claims 1-27 of the instant application have been determined to include linking claims 1 and 17. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1 and 17. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

This application contains claims directed to the following patentably distinct inventions linked by claims 1 and 17.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups I-III. Claims 1, 3, 10-16, 21-22, drawn to a compound comprising a target cell-specific portion and a cytotoxic portion, which is a caspase-3 or caspase-6 or

Art Unit: 1642

caspase-7, classified in class 530, subclass 350. Each of the compound comprising a target cell-specific portion and a single caspase is a separate invention.

Groups IV-VI. Claims 2, 4-9, drawn to a compound comprising a mediator portion capable of recognize a cell-specific molecule and a cytotoxic portion, which is a caspase-3 or caspase-6 or caspase-7, classified in class 530, subclass 350. Each of the compound comprising a mediator portion and a single caspase is a separate invention.

Groups VII-X. Claims 17-20, drawn to a nucleic acid molecule encoding to a compound comprising a target cell-specific portion and a cytotoxic portion, which is a caspase-3 or caspase-6 or caspase-7, classified in class 536, subclass 23.1. Each of the nucleic acid molecules encoding a compound comprising a target cell-specific portion and a single caspase is a separate invention.

Group XI. Claims 17-20, drawn to a nucleic acid molecule encoding to a compound comprising a target cell-specific portion, classified in class 536, subclass 23.1.

Group XII. Claims 17-20, drawn to a nucleic acid molecule encoding to a compound comprising a mediator portion, classified in class 536, subclass 23.1.

Groups XIII-XV. Claims 17-20, drawn to a nucleic acid molecule encoding to a compound comprising a cytotoxic portion, which is a caspase-3 or caspase-6 or caspase-7, classified in class 536, subclass 23.1. Each of the nucleic acid molecules encoding a single caspase is a separate invention.

Groups XVI-XVIII. Claims 23-27, drawn to a method for treating diseases or cancer, comprising administering a compound comprising a target cell-specific portion and a cytotoxic portion, which is a caspase-3 or caspase-6 or caspase-7, classified in class 514, subclass 4. Each of the method using a compound comprising a target cell-specific portion and a single caspase is a separate invention.

The inventions are distinct, each from each other because of the following reasons:

Inventions (I-XV) and (XVI-XVIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h)). In this instant case, a polypeptide could be used for several purposes, e.g. for biochemical assay, for making antibodies, and for making an affinity column to purify its antibodies; a DNA sequence could be used for the detection of similar DNA or RNA sequences, for making an expression vector, and for producing its encoded protein.

The products of groups I-XV are patentably distinct, because they are drawn to entirely different biochemicals, having different structures, biological properties and activities.

The methods of groups XVI-XVIII are distinct from each other because they differ at least in reagents and/or dosages, and/or schedules used, response variables and criteria for success.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

SUSAN UNGAR, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Susan Ungar', is written over the printed name and title.

Application/Control Number: 09/819,266

Page 6

Art Unit: 1642

MINH TAM DAVIS

August 25, 2002

SUSAN UNGAR, PH.D
PRIMARY EXAMINER